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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,482	04/13/2004	William C. Fisher	2802-159-036	4955

7590

07/18/2005

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EXAMINER
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BOCHNA, DAVID

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,482	<b>Applicant(s)</b> FISHER ET AL.	
	<b>Examiner</b> David E. Bochna	<b>Art Unit</b> 3679	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-19 and 27-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-19, 27-36 and 43 is/are allowed.
- 6) ☒ Claim(s) 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/11/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 9/17/05 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it is not proper to list the “copy of notification of transmittal of the international search report” and “the written opinion” on the IDS as those documents are not considered prior art. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Boche.

In regard to claim 37, Boche discloses a generally tubular nipple (see fig. 2A) having a longitudinal axis, a first end, a second end, an outer surface with a series of circumferential

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grooves located between said first and said second ends (“for affixedly receiving a generally cylindrical shell” is considered an intended use recitation and is given little patentable weight if the structure of the prior art is capable of fulfilling the intended use of the claimed invention. In this case the series of circumferential grooves 38, 33 and groove where D3 are located are all dimensioned to and capable of receiving a surface of a cylindrical shell), and a bore extending from said first end to said second end;

wherein said series of circumferential grooves are dimensioned for affixedly receiving at least one of an inside surface, an end surface and an outside surface of said generally cylindrical shell; and said series of grooves comprising;

a first groove 38 with a generally flat base portion parallel with said longitudinal axis, a first substantially radially directed sidewall, and a second substantially radially directed sidewall;

a second groove 33 adjacent said first groove, with a generally flat base portion parallel with said longitudinal axis having a diameter less than said first groove base portion, a first substantially radially directed sidewall, having a maximum radial extent generally equal to said first groove second sidewall, and a second substantially radially directed sidewall;

and a third groove (groove where D3 is located) adjacent said second groove, with a generally flat base portion parallel with said longitudinal axis having a diameter less than said second groove base portion, a first substantially radially directed sidewall 34, having a maximum radial extent generally equal to said second groove second sidewall, and a second substantially radially directed sidewall (sidewall of first protrusion 35).

In regard to claim 38, wherein said first groove second sidewall and said second groove second sidewall have a contoured top portion.

In regard to claim 39, wherein said first groove second sidewall and said second groove second sidewall have an angled top portion (sidewalls are angled at a 90 degree angle to the outside circumferential surfaces).

In regard to claim 40, further including an insert portion located between said third groove and said second end and has a plurality of spaced, circumferentially extending, frusto-conically shaped protrusions 35 on the outer surface thereof.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boche.

Boche discloses a nipple as described above, but does not disclose that one of the protrusions is larger than the others on the nipple. However, it would have been obvious to make one of the protrusions larger because a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

6. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boche in view of Boer et al. Boche discloses a nipple as described above that creates a safer connection with improved pull out forces, but Boche does not disclose adding surface disruptions to the groove. Boer et al. teaches supplying grooves 5 with surface disruptions 6 in order to prevent shell rotation and make a more secure connection between the nipple and cylindrical shell. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention

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was made to modify the groove of Boche to include disruptions, as taught by Boer et al., in order to improve the connection qualities of the coupling.

***Allowable Subject Matter***

7. Claims 4-19 and 27-36 and 43 are allowed.

***Response to Arguments***

8. Applicant's arguments filed 5/11/05 have been fully considered but they are not persuasive.

In response to applicant's argument that Boche does not disclose more than one circumferential groove for affixedly receiving a shell, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the series of circumferential grooves 38, 33 and the groove where D3 is located are all capable of receiving a surface of a cylindrical shell.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (571) 272-7078. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David E. Bochna  
Primary Examiner  
Art Unit 3679